



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/920,443

07/31/2001

Davin J. Fifield

5628.02

4657

20686

7590

10/14/2003

DORSEY & WHITNEY, LLP
INTELLECTUAL PROPERTY DEPARTMENT
370 SEVENTEENTH STREET
SUITE 4700
DENVER, CO 80202-5647

EXAMINER

CAPUTO, LISA M

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 10/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/920,443	FIFIELD ET AL.	
	Examiner	Art Unit	
	Lisa M Caputo	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 January 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>092903</u> | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Drawings

1. The drawings are objected to because Figures 1-2, 4-9, 11, 15, 17A-D, 20A-D, 22A-B, and 23 do not contain reference numerals and hence are not clearly detailed and explained. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Muranaga et al. (U.S. Patent No. 5,671,428, from hereinafter "Muranaga") in view of Kish et al. (U.S. Patent No. 5,890,176, from hereinafter "Kish").

Muranaga teaches a collaborative document processing system with version and comment management. Muranaga discloses that referring now to FIG. 1, the first embodiment of a document processing system according to the present invention will be described in detail. In this first embodiment, the document processing system comprises: a plurality (two in FIG. 1) of personal terminal devices 1 and 2 such as personal computers or work stations, each of which is assigned to each one of collaborating authors, and which are interconnected through a network 3; and a document database 4 connected with the personal terminal devices 1 and 2 through the network 3, which is shared by all the personal terminal devices 1 and 2. Here, the personal terminal devices 1 and 2 have the identical internal configuration, so that the internal configuration of only the personal terminal device 1 is shown in FIG. 1 and will be described in detail below. The personal terminal device 1 further comprises: a display device 11 such as a bit map display equipped with a multiple window management function; an input device 12 such as a keyboard and a mouse; an input and output (I/O) control unit 13 connected to the display device 11 and the input device 12; an editor unit 14 connected to the input and output control unit 13, which includes a document editor 141, a comment editor 142, and a version data display unit 143; a document data management unit 15 connected to the editor unit 14, which includes a document management unit 151, a comment management unit 152, and a version

management unit 153; and a document database access unit 16 connected to the document data management unit 15 and the network 3. The document database 4 further comprises: a document memory unit 41 for storing documents to be processed; a comment memory unit 42 for storing comments to be attached to the documents stored in the document memory unit 41; and a version data memory unit 43 for storing version data for the documents stored in the document memory unit 41. The document data including the documents stored in the document memory unit 41, the corresponding comments stored in the comment memory unit 42, and the corresponding version data stored in the version data memory unit 43 can be read out to each of the personal terminal devices 1 and 2 through the network 3, and updated by the new document data newly obtained at the personal terminal device 1 and 2 through the network 3. In this document processing system of FIG. 1, the document is processed at the editor unit 14 according to the commands given by an author through the input device 12, while the document under the processing at the editor unit 14 is displayed on the display device 11, and the document data for the document under the processing at the editor unit 14 are managed at the document data management unit 15 and stored in the document database 4 through the network 3, by maintaining the correspondences among the documents, comments, and version data.

Referring now to FIG. 2, the operation of this first embodiment of a document processing system of FIG. 1 will be described in detail. FIG. 2 shows an exemplary display on the display device 11 in the document processing system of FIG. 1, which includes separate windows A, B, and C for the document editor 141, the comment editor

142, and the version data display unit 143, respectively. FIG. 2 shows an example of a case in which all of these windows are opened at the same time. In FIG. 2, the windows A and A' are showing a new version and an old version of the same document, respectively, simultaneously in parallel, while the window B is showing a comment attached to the old version of the document shown in the window A'. In this exemplary case, the comment shown in the window B indicates the reason for the modification made from the old version shown in the window A' to the new version shown in the window A. The window C is showing the version data for the old and new versions of the document shown in the windows A' and A, which indicate the modification made from the old version to the new version. Here, any unit of the editor unit 14 can be activated from any other units of the editor unit 14. That is, for example, either one of the comment editor 142 or the version data display unit 143 can be activated from the document editor 141, and so on. In addition, any other document editor 141 showing the other document can also be activated from the editor unit 141 showing the currently processed document. In this first embodiment, each author edits the document by using the document editor 141. During this editing processing, the author can see the older version of the currently processed document or the comment attached by the other collaborating authors, on the same display on which the currently processed document is shown. In addition, the author can attach the comment to any document written by the collaborating authors, on the same display. The document data such as the documents, comments, and version data obtained by the processing at the editor unit 14 are managed by the document data management unit 15, and are stored in the

document database 4 through the document database access unit 16 and the network 3, after the completion of the processing at the editor unit 14. The document data stored in the document database 4 can be accessed from the personal terminal devices 1 and 2, such that the author can attach the comment to any desired document by accessing to the desired document at the document editor 141 and by using the comment editor 142. The comment given by each author is also stored as a part of the document data in the document database 4, such that the other collaborating authors can also see the comment by accessing to the desired comment at the comment editor 142. Thus, in this document processing system of FIG. 1, the sufficient communication among the collaborating authors can be realized by sharing the comments attached to the document which are stored in correspondence to the document in the document database 4, among all of the collaborating authors, such that the collaborative document processing work can be realized more smoothly and efficiently (see Figures 1-2, col 6 line 55 to col 8 line 35).

Hence, Muranaga teaches a method for transferring annotations associated with a draft electronic transcript to a revised electronic transcript by using different document memories (i.e. the document data including the documents stored in the document memory unit 41, the corresponding comments (annotations) stored in the comment memory unit 42, and the corresponding version data (draft or revised document) stored in the version data memory unit 43 can be read out to each of the personal terminal devices 1 and 2 through the network 3, and updated by the new document data newly obtained at the personal terminal device 1 and 2 through the network 3. In this

document processing system of FIG. 1, the document is processed at the editor unit 14 according to the commands given by an author through the input device 12, while the document under the processing at the editor unit 14 is displayed on the display device 11, and the document data for the document under the processing at the editor unit 14 are managed at the document data management unit 15 and stored in the document database 4 through the network 3, by maintaining the correspondences among the documents, comments, and version data).

Regarding claim 1, Muranaga fails to teach that a determination is made on whether the revised electronic transcript is derived from the draft electronic transcript.

Kish teaches an object-oriented document version tracking method and apparatus. Kish discloses that the foregoing objects are achieved and the foregoing problems are overcome by one illustrative embodiment of the invention in which a single file holds multiple versions of a document. The document is composed of an interconnection of objects which themselves have versions and are stored in the file. When the document is changed by changing any of the interconnected objects, a check is first made to determine whether the object version is same as the document version currently being edited. If not, a copy of the object is made and saved. Any version of the document can be reconstructed by interconnecting object versions which have a highest level which is equal to, or less than, the desired document version. Therefore, only objects which are changed are duplicated and copies of objects are only made when an object changes (see Figures 1-9, col 2, lines 20-35, col 2 line 8 to col 9 line 41). Hence, Kish teaches that a determination is made on whether the object version (revised

Art Unit: 2876

electronic transcript) is derived from the document version being edited (draft electronic transcript).

In view of the teaching of Kish, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the determination if the revised electronic transcript is derived from the draft electronic transcript because it is important that the documents are not misread or communicated to the wrong person. Hence, it is favorable to be assured that the document being annotated is indeed the correct matching document.

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Lisa M. Caputo** whose telephone number is **(703) 308-8505**. The examiner can normally be reached between the hours of 8:30AM to 5:00PM Monday through Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 703-305-3503. The fax phone number for this Group is (703) 872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [**lisa.caputo@uspto.gov**].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

LMC

LMC

September 30, 2003

Diane I. Lee
DIANE I. LEE
PRIMARY EXAMINER